

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed March 11, 2004. At the time of the Office Action, Claims 1-3, 6-15, and 18-22 were pending in the Application. Applicant amends Claims 1-3, 6-15, and 18-22. It is important to note that the amendments are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues, only further clarify subject matter already present, and have been made only to advance the prosecution of this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-3, 6, 11-15, and 18 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,353,742 issued to Bach (hereinafter "*Bach*"). Applicant respectfully traverses this rejection for the following reasons.

Independent Claim 1, as amended, recites:

An apparatus, comprising:

a selection and distribution unit that is included within a base station controller, the selection and distribution unit being operable to:

(a) receive signal quality information from a plurality of base transceiver stations about a plurality of data streams that are associated with a plurality of mobile stations which are capable of moving within a wireless network;

(b) select one of the plurality of data streams associated with a selected one of the mobile stations to be forwarded; and

(c) direct reverse communication traffic associated with the selected mobile station to a selected one or more of the plurality of base transceiver stations, wherein the selected mobile station determines which base transceiver station is to accommodate an associated communication session based on signal quality information determined by the selected mobile station.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Using the preceding well-settled jurisprudence, it is clear that *Bach* fails to anticipate Independent Claim 1. For example, *Bach* fails to teach, suggest, or disclose a selection and distribution unit that is included within a base station controller, the selection and distribution unit being operable to... direct reverse communication traffic associated with the selected mobile station to a selected one or more of the plurality of base transceiver stations, wherein the selected mobile station determines which base transceiver station is to accommodate an associated communication session based on signal quality information determined by the selected mobile station, as recited in Independent Claim 1. Indeed, *Bach* fails to disclose any information relating to the return path of traffic that is associated with the given mobile station that is being serviced by the selection and distribution unit (which takes into account signal quality information from a plurality of base transceiver stations about a plurality of data streams). Because *Bach* fails to teach, suggest or even remotely disclose this limitation, *Bach* is precluded from inhibiting the patentability of Independent Claim 1.

Claims 2-3 and 6-10 depend from Independent Claim 1 and are, therefore, also allowable over *Bach* for similar reasons. In addition, Independent Claims 11, 12, and 13 include a similar limitation and are allowable for analogous reasons.

Section 103 Rejection

The Examiner rejects Claims 7-10 and 19-22 under 35 U.S.C. §103(a) as being unpatentable over *Bach* in view of U.S. Patent No. 6,141,347 issued to Shaughnessy et al. (hereinafter "*Shaughnessy*"). Applicant respectfully traverses this rejection for the following reasons.

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.⁵

It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. This prong of the §103 analysis has been evaluated thoroughly above. Furthermore, Applicant notes that the *Shaughnessy* reference, also cited by the Examiner in his §103 rejection, fails to offer any additional disclosure combinable with *Bach*, which would inhibit the patentability of any of the pending claims. The *Shaughnessy* reference is engaged in multicast addressing (See abstract of *Shaughnessy*), but fails to implement any such operations in the context of receiving signal quality information. Clearly this is not akin to the pending subject matter. For at least these reasons, the pending claims are patentably distinct from *Shaughnessy* and *Bach*.

Even assuming for the sake of argument that *Shaughnessy* and *Bach* disclose the elements of the pending claims, the §103 rejection would still be improper because the Examiner has not shown the required suggestion or motivation in *Shaughnessy* and *Bach*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.⁶ Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.⁷ Nothing in *Shaughnessy* or *Bach* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁸ Speculation in hindsight that “it would have been obvious” to make the proposed combination because the

⁵ See M.P.E.P. § 2142-43.

⁶ M.P.E.P. § 2143.01 (emphasis in original).

⁷ In *re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁸ If “common knowledge” or “well known” art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

proposed combination would be helpful is insufficient under the M.P.E.P.⁹ and governing Federal Circuit case law.¹⁰ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.¹¹

Thus, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.¹² The factual inquiry whether to combine references must be thorough and searching.¹³ This factual question cannot be resolved on subjective belief and unknown authority;¹⁴ it must be based on objective evidence of record.¹⁵ Furthermore, the Examiner is precluded from modifying the combined teachings of *Shaughnessy* and *Bach* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹⁶ The fact that the modification is possible or even advantageous is not enough.¹⁷ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹⁸

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. There is no showing by the Examiner that the teachings of *Bach* and *Shaughnessy* could provide the provision for return

⁹ See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

¹⁰ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

¹¹ See M.P.E.P. §2145.

¹² See *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986).

¹³ See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

¹⁴ See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002).

¹⁵ *Id.* at 1343, 61 USPQ 2d at 1434.

¹⁶ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹⁷ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹⁸ *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

traffic identified above; nor is there any disclosure relating to the other elements identified in the pending claims in the analysis provided supra. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Shaughnessy-Bach* combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness. Thus, the Examiner has not met each of the criteria to support a proper §103 analysis. This has been evaluated (and properly supported) extensively in the analysis provided above.

Therefore, all of the pending claims are allowable. Notice to this effect is respectfully requested in the form of a full allowance of all the pending claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Although Applicant believes that no fee is due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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